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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,477	01/04/2001	Brad A. Armstrong		3561

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EXAMINER
NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
2674	3

DATE MAILED: 09/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/754,477	ARMSTRONG, BRAD A.	
	Examiner	Art Unit	
	Kevin M. Nguyen	2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 January 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 15 of U.S. Patent No. 6,198,473. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an improved desktop operated computer control device of the type having a rotatable ball for pointing control corresponding to a improved mouse of the type having surface-tracking for pointing control; a housing, an electronic circuitry, the buttons, the pressure-sensitive variable-conductance sensors; at least three readable states of varied conductance.

3. Claims 8-10 and 12-30 are rejected under the judicially created doctrine of double patenting over claims 1-14 and 16-28 of U. S. Patent No. 6,198,473, since the

claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: an improved desktop operated computer control device of the type having a rotatable ball for pointing control corresponding to a improved mouse of the type having surface-tracking for pointing control; a housing, an electronic circuitry, the buttons, the pressure-sensitive variable-conductance sensors; scrolling speed rates; a back forward button without a moving cursor; and a forward button without a moving cursor.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Nassimi (US 5,790,102).

As to claim 8, Nassimi teaches a method of controlling window scrolling using a mouse 10 having a surface-tracking 12 for controlling a cursor 22 comprising

depressing an analog scroll control button 62 for controlling variable screen scrolling rate by way of selecting the pressure (38, 32, 36, 34) applied to said analog scroll control button 62 (see figure 2, column 17, lines 5-67).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 12-30 are rejected under 35 U.S.C. 102(a) as being anticipated by Adan et al (US Patent Application Publication 2002/0036660 A1).

As to claims 12-15, 18, 20, 22, 23, 24-26, 29, 30, Adan et al teaches a computer mouse 101 associating a method thereof which includes, a housing (102, 103), a trackball 119, a rocker button 200 (see figure 2A, 2B, page 2, paragraph [0028, 0029]), communicating a first command signal to software 270, a display screen 560, a window 562, Internet Explorer®, (see page 6, paragraph [0081]), said first command signal activating display of information of a previous page 570, said activating occurring without a requirement of a cursor having to be located on a back button 566 on a display 560 (see figures 6A, 6B, page 6, paragraph [0083], [0085]).

As to claims 16, 17, 19, 21, 27, 28, Adan et al teaches said second command signal activating display of information of a forward page 576, said activating occurring without a requirement of a cursor having to be located on a back button 566 on a display 560 (see figures 6A, 6C, page 7, paragraph [0083], [0087]).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nassimi in view of Adan et al.

As to claim 9, Nassimi teaches all of the claimed limitation of claim 9, except for said pointer controlled by said mouse is not required to be located on a scrolling elevator showing on a monitor. However, Adan et al teaches increasing pressure 108 applied to said analog scroll control button for increasing scrolling rate by the wheel 106, and scrolling a window 562 being controlled by a wheel 106 of a computer mouse 101 without moving a cursor (see figure 2A, 6A, page 2, paragraph [0028], and page 6, paragraph [0083]). It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize scrolling a window 562 being controlled by a wheel 106 of a computer mouse 101 without moving a cursor taught by Adan et al for Nassimi's computer mouse because this would improve the quality of the window scrolling being controlled faster.

As to claim 10, Adan et al teaches decreasing pressure 108 applied to said analog scroll control button for decreasing scrolling rate by the wheel 106 (page 2, paragraph [0028]).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kevin M. Nguyen** whose telephone number is **703-305-6209**. The examiner can normally be reached on MON-THU from 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard A Hjerpe** can be reached on **703-305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Kevin M. Nguyen
Patent Examiner
Art Unit 2674

KN
September 17, 2003

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600